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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI,
P.C.

20333 SH 249
SUITE 600
HOUSTON, TX 77070

EXAMINER

FERRIS, DERRICK W

ART UNIT PAPER NUMBER

2663

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,586

Applicant(s)

EVEN, RONI

Examiner

Derrick W. Ferris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.11.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 09/05/03 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. However, the examiner went ahead and obtained the references cited in the IDS. Thus the references have been considered and no further action is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-3, 6-8, 11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over “Gateway for H.323 Media Transport Over ATM” to *ATM Forum* in view “VTOA/VoIP/ISDN Telephony Gateway” to *Manuel et al.* (“*Manuel*”) and “Packet-based multimedia communications systems” to *ITU-T H.323*.

In making a proper obviousness rejection under MPEP 706.02(j), the examiner will address the following four steps:

- a) *the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line numbers where appropriate;*
- b) *the difference of differences in the claim(s) over the applied cited references;*
- c) *the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter; and*

- d) *an explanation why one skilled in the art at the time of the invention was made would have been motivated to make the proposed modification.*

As such to **claim 1**, for step (a) *ATM Forum* discloses in figure 1 on page 3 a first endpoint (e.g., H.323 terminal), a first gateway (e.g., H.323 to H.323 Gateway), an ATM backbone, a second gateway (e.g., H.323 to H.323 Gateway) and a second endpoint (e.g., H.323 terminal). Although *ATM Forum* focuses on compressed RTP over an ATM media stream transport, the reference also discloses RTP over ATM media transport streams between the gateways (i.e., H.323/Annex C), see e.g., page 5. Thus the issue here is showing a non-H.323 terminal connected to the gateway.

For step (b) *ATM Forum* may be silent or deficient to the further limitation wherein at least one endpoint is not supporting H.323. In particular, although two H.323 terminals are shown in figure 1 on page 3, *ATM Forum* also teaches that Interworking is possible in Section 4 starting on page 28. Specifically, that interworking between H.Series protocols is known in the art and that H.320 is possible for simple telephone connections as also mentioned in Section 4.4 at page 29. However, what may not be clear from *ATM Forum* is how interworking is performed. Thus the examiner notes the following obviousness rejection below for clarification.

Manuel and *ITU-T H.323* teach the further recited limitation above at e.g., in figure 4 on page 231 of *Manuel* and in figure 1 on page 2 of *ITU-T H.323*.

For step (c), the proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *ATM Forum* by clarifying that the interworking is performed in the gateway to support a non-323 device.

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In order to establish a prima facie case of obviousness for step (d), three basic criteria must be met. The three criteria according to MPEP 706.02(j) are as follows:

First there must be some suggestion or modification, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As such, for step (d) examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the further limitation wherein at least one endpoint is not supporting H.323. In particular, the motivation for modifying the reference or to combine the reference teachings would be since interworking between various multimedia terminal on ATM or on alternative network technologies is of prime importance. In particular, *ATM Forum* cures the above-cited deficiency by providing the motivation found at e.g., top of page 28. Examiner also notes a further motivation of terminal interoperability with respect to H.323 networks. Second, there would be a reasonable expectation of success since both *Manuel* and *ITU-T H.323* disclose performing the conversion at the gateway for H.323. In particular, *Manuel* discloses interoperability at the gateway in order to communicate with ISDN, legacy LAN (i.e., VoIP) and private ATM. *ITU-T H.323* further clarifies that the ISDN uses an H.320 terminal and that ATM uses a H.321 terminal with respect to H.323 where the conversion is performed at the H.323 gateway connected to a packet based network (e.g., ATM is a packet based network). Thus the references either in singular or in combination teach the above claim limitation(s).

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As to **claim 2**, see e.g., *Manuel* which teaches ISDN interoperability at the gateway shown in figure 4 on page 231, or *ITU-T H.323* which teaches ISDN interoperability at the H.323 gateway using an H.320 terminal shown in figure 1 on page 2.

As to **claim 3**, see e.g., *Manuel* which teaches ATM interoperability at the gateway shown in figure 4 on page 231, or *ITU-T H.323* which teaches ATM interoperability at the H.323 gateway using an H.321 terminal shown in figure 1 on page 2.

As to **claim 6**, see similar rejection to claim 1.

As to **claim 7**, see similar rejection to claim 2.

As to **claim 8**, see similar rejection to claim 3.

As to **claim 11**, see similar rejection to claim 1.

As to **claim 12**, see similar rejection to claim 1.

4. **Claims 4, 5, 9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over “Gateway for H.323 Media Transport Over ATM” to *ATM Forum* in view “VTOA/VoIP/ISDN Telephony Gateway” to *Manuel et al.* (“*Manuel*”) and “Packet-based multimedia communications systems” to *ITU-T H.323* in further view of “An Architecture for Residential Internet Telephony Service” to *Huitema et al.* (“*Huitema*”).

As to **claim 4**, *ATM Forum*, *Manuel* and *ITU-T H.323* are silent or deficient to specifically mentioning SIP. In particular, *Manuel* discloses a gateway that uses VoIP but does not specifically mention SIP. *Huitema* mentions SIP for using in VoIP while discussing the Media Gateway Control Protocol, which is a protocol similar to SIP, e.g.,

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see abstract on page 50. In particular, *Huitema* also teaches a relationship between SIP and H.323. Thus the examiner purposes to modify at least *Manuel* to clarify that SIP is used as part of VoIP for the Internet. Hence examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the further limitation where at least one of the first endpoint and second endpoints support SIP communications. In particular, one skilled in the art would be motivated to use SIP in order to be interoperable with SIP devices on the Internet for VoIP applications. *Huitema* helps cure the above cited deficiency by providing the motivation that SIP was originally developed for establishing multimedia conferences over the Internet, see e.g., page 50 left-hand column.

As to **claim 5**, see similar rejection to claim 4.

As to **claim 9**, see similar rejection to claim 4.

As to **claim 10**, see similar rejection to claim 5.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US006202084B1 may be relevant to claims 6-8 although it may not be clear that H.323 Annex C is taught.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225.

The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Derrick W. Ferris
Examiner
Art Unit 2663

DWF



CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600 6/24/09